REMARKS

Applicant hereby traverses the outstanding objections and rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-20 are pending in this application.

Objection to the Drawings

The Examiner has objected to the drawings, specifically that Figure 1 should be labeled "Prior Art", that reference numbers 201 and 1 202-1 are not shown in any Figure, that reference numbers 300 and 400 of Figures 3 and 4, respectively, are not discussed in the specification, and that a limitation of claim 6, namely "emulated power cycling of the emulating storage system" is not shown in any Figure.

In response, Applicant has amended Figure 1 to be labeled "Prior Art", amended Figure 2 to include a label "201", and has amended the specification to change "1 201-1" to "204-1". Applicant has also amended the specification to include "300" and "400".

With regards to the objection that a limitation of claim 6, namely "emulated power cycling of the emulating storage system" is not shown in any Figure, Applicant respectfully request reconsideration of this objection. Applicant notes that the emulating storage system is shown in at least one Figure, e.g. 204-1 of Figure 1. Consequently, Applicant believes that this limitations is adequately shown in the Figures.

As each identified instance of informality has been corrected with a corresponding proposed amendment or addresses with an argument, Applicant believes that the objection to the drawings has been overcome, and that this objection should be withdrawn.

Objection to the Specification

The specification is objected to in the Office Action, as requiring update of the current status of the referenced applications. The referenced application at page 1 of the specification has been amended the specification to include updated information with respect to the referenced applications. Thus, Applicant believes that the objection to the specification has been overcome, and that this objection should be withdrawn.

Rejection under 35 U.S.C. § 112

Claims 5 and 19 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the words "substantially approximating" in claims 5 and 19 are asserted by the Office Action as being unclear.

In response, Applicant has amended claims 5 and 19 to more accurately and precisely define the invention by deleting the word "substantially". The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment, Applicant respectfully requests the rejection of claims 5 and 19 under 35 U.S.C. § 112, second paragraph be withdrawn.

Rejection under 35 U.S.C. § 102

Claims 1-6 and 8-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamamoto ('719).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

Claim 1 defines a system for providing accurate data storage emulation in a computer system, the system having an emulating storage system in communication with said emulating computer dedicated to emulation of an operation of at least one of said at least one storage systems. Yamamoto does not disclose at least this limitation. Yamamoto discloses various memories, e.g. emulation memory 12, trace memory 18, and preservation memory 19, none of which are dedicated to emulation of an operation of at least one of said at least

one storage systems. Instead these memories store information received from the host computer (memory 12), store trace information (memory 18), and store data that is used by the target system (memory 19). Consequently none of these memory meet the limitations of the claimed emulating storage system. Thus, Yamamoto does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 9 defines a method that includes dedicating said coupled emulating storage system to emulation of said at least one storage system native to said host computer system. Yamamoto does not disclose at least this limitation. Yamamoto discloses various memories, e.g. emulation memory 12, trace memory 18, and preservation memory 19, none of which are dedicated to emulation of said at least one storage system native to said host computer system. Instead these memories store information received from the host computer (memory 12), store trace information (memory 18), and store data that is used by the target system (memory 19). Consequently none of these memory meet the limitations of the claim 9. Thus, Yamamoto does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 9 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 16 defines a system for emulating an operation of at least one storage device adapted for operation with a host computer system, the system comprises means for dedicating an emulating storage device to each of said at least one storage devices adapted for operation with said host computer system, thereby establishing at least one dedicated emulating storage device. Yamamoto does not disclose at least this limitation. Yamamoto discloses various memories, e.g. emulation memory 12, trace memory 18, and preservation memory 19, none of which are dedicating an emulating storage device to each of said at least one storage devices adapted for operation with said host computer system, thereby establishing at least one dedicated emulating storage device. Instead these memories store information received from the host computer (memory 12), store trace information (memory 18), and store data that is used by the target system (memory 19). Consequently none of these memory meet the limitations of the claimed dedicated emulating storage device. Thus, Yamamoto does not teach all of the claimed limitations. Therefore, the Applicant

respectfully asserts that for the above reasons claim 16 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 2-6, 8, 10-15, and 17-20 depend from base claims 1, 9, and 16, respectively, and thus inherit all limitations of their respective base claims. Each of claims 2-6, 8, 10-15, and 17-20 sets forth features and limitations not recited by Yamamoto. Thus, the Applicant respectfully asserts that for the above reasons claims 2-6, 8, 10-15, and 17-20 are patentable over the 35 U.S.C. § 102 rejection of record.

Rejection under 35 U.S.C. § 103

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of logical reasoning.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy the third criteria.

The Office Action admits that Yamamoto does not teach having an emulating storage system that comprises a hard disk drive having a storage capacity substantially equal to a storage capacity of a hard disk drive. The Office Action attempts to cure this deficiency by introducing logical reasoning, which the Office Action relies upon to provide such a teaching. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Base claim 1 is defined as described above. Yamamoto does not disclose these limitations, as discussed above. Logical reasoning is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claim 7 depends from base claim 1, and thus inherits all limitations of claim 1. Claim 7 sets forth features and limitations not recited by the combination of Yamamoto and logical reasoning. Thus, the Applicant respectfully asserts that for the above reasons claim 7 is patentable over the 35 U.S.C. § 103(a) rejection of record.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10002222-1, from which the undersigned is authorized to draw.

Dated: June 23, 2004

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734602US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: June 23, 2004

Signature: _____
Lisa J. Collins

Attachments